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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/051,670    09/08/98    NAKAGAWA

N    FJN-063

EXAMINER

HM12/0501

PATENT ADMINISTRATOR  
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ART UNIT

PAPER NUMBER

1646

17

DATE MAILED:

05/01/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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# Office Action Summary

Application No.  
09/051,670

Applicant(s)  
Nakagawa et al.

Examiner  
David S. Romeo

Group Art Unit  
1646



☒ Responsive to communication(s) filed on 3 Apr 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1, 2, 5, and 6 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1, 2, and 5 is/are allowed<sup>able</sup>~~ed~~.

☒ Claim(s) 6 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☒ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1646

**DETAILED ACTION**

1. The finality of the rejection of the last Office action is withdrawn.

2. The after final amendment filed 04/03/00 (Paper No. 16) has been entered. Claims 1, 2, 5, 6 are pending.

3. Any objection or rejection of record that is not maintained in this Office action is withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**New formal matters, objections, and/or rejections:**

***Priority***

4. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).

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***Claim Objections***

5. Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The protein encoded by a DNA molecule comprising SEQ ID NO:1 followed by SEQ ID NO:2 does not encode SEQ ID NO:3, as discussed below, and said protein does further limit and does not infringe a protein comprising SEQ ID NO:3.

6. Claim 6 is objected to because of the following informalities: there is a misplaced "." after "SEQ". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 6 is directed to a recombinant method of making the protein of claim 5 using a DNA molecule comprising SEQ ID NO:1 followed by SEQ ID NO:2. The protein of claim 5 is directed to a protein comprising the amino acid sequence of SEQ ID NO:3. However, a DNA molecule comprising SEQ ID NO:1 followed by SEQ ID NO:2 does not encode the amino acid sequence of

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SEQ ID NO:3 because SEQ ID NO:1 encodes Lys at amino acid number three whereas the amino acid at position three of SEQ ID NO:3 is Asn. Moreover, claim 6 encompasses the production of SEQ ID NO:3 in mammalian host cells. However, one skilled in the art would reasonably expect that the signal peptide of SEQ ID NO:3 would be cleaved upon expression of a DNA molecule comprising SEQ ID NO:1 followed by SEQ ID NO:2 and the secretion of the protein encoded thereby. The specification has not told the skilled artisan how to produce a protein comprising the amino acid sequence of SEQ ID NO:3 with a DNA molecule comprising SEQ ID NO:1 followed by SEQ ID NO:2, nor has the specification told the skilled artisan how to obtain SEQ ID NO:3 in a mammalian host that cleaves the signal peptide.

### ***Conclusion***

8. Claims 1, 2, 5 are allowable.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David S. Romeo whose telephone number is (703) 305-4050. The examiner can normally be reached on Monday through Friday from 6:45 a.m. to 3:15 p.m.

5 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242.

Faxed draft or informal communications should be directed to the examiner at (703) 308-0294.

10 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
**DAVID ROMEO**  
**PATENT EXAMINER**  
April 27, 2000